

REMARKS

Claims 1-36 were pending in the above-identified application. Claims 1, 3-9, 12, 14-15, 17-24, 26, 28-36 have been amended and claims 2 and 16 have been cancelled. Claims 33 and 34 are allowable if rewritten as set forth in the Office Action. Claims 5, 19, 29, and 31 were objected to for informalities and claims 1-36 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1-3, 5-10, 12-17, 19-24, 26-30, 32, 35, and 36 were rejected under 35 U.S.C. § 102(e). Claims 1-11, 14-25, 28-32, 35, and 36 were rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses these rejections for at least the reasons articulated below.

I. OBJECTIONS

Claims 5, 19, 29, and 31 were objected to due to informalities. Applicant has accepted the recommendations of the Examiner and has amended the claims accordingly. Applicant respectfully requests that objection on this basis be reconsidered and withdrawn.

II. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Office Action states that the terms "a selected separation product" of "a sample constituent" is unclear in claims 1, 15 and 28. In those same claims, the Office action also states that the phrase "an apparatus for processing compounds is also unclear. Applicant has amended claims 1, 15, and 28 to address the Examiner's concerns.

The Office Action also states that the term "small volume" is unclear in claims 2-4 and 16-18. Applicant has amended claims 3-4 and 17-18 to address the Examiner's concerns. As Applicant has cancelled claims 2 and 16, any concerns based on these claims are moot.

The Office action states that the phrases “selected salts in the sample”, “the mixture”, and “at least one compound” lack antecedent basis in claims 33 and 34. Antecedent basis for the term “at least one compound” may be found in the preamble of claims 33 and 34. Applicant has otherwise amended claims 33 and 34 in accordance with the Examiner’s concerns. Applicants respectfully submit that these claims are now in condition for allowance and rejection be reconsidered and withdrawn.

III. REJECTION UNDER 35 U.S.C. § 102(e)

Claims 1-3, 5-10, 12-17, 19-24, 26-30, 32, 35, and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Speicher et al. (U.S. patent No. 6,638,408). Applicant respectfully traverses this rejection for at least the following reasons.

Speicher does not disclose each and every limitation contain in independent claims 1, 15, 28, 35, and 36. For example, the amended claims in the present application require a non-isoelectric separation barrier. By contrast, Speicher requires isoelectric focusing membrane partitions because the separation process disclosed in the cited reference is achieved solely by isoelectric focusing. “This invention provides a novel solution isoelectric focusing device and method”. (Speicher, abstract). As such, each of the membrane partitions contemplated by Speicher must be comprised at a particular pH, and thus must be isoelectric. “[E]ach porous charged partition comprises a pH different from any other membrane partition.” (Speicher, col. 6, ln. 17-18).

None of the membranes disclosed in Speicher reveal use of a non-isoelectric membrane as required by the present claims. Without this limitation, Speicher does not disclose each an every limitation recited in amended, independent claims 1, 15, 28, 35, and 36. Correspondingly, because claims 2-3, 5-10, 12-14, 17, 19-24, 26-27, 29-30, 32, and 35 depend from these

independent claims, they are similarly distinguished from Speicher. As claims 2 and 16 have been cancelled, rejection of these claims is moot. Applicant respectfully request that rejection under 35 U.S.C. §102(e) be reconsidered and withdrawn.

III. REJECTION UNDER 35 U.S.C. §103(a)

Claims 1-11, 14-25, 28-32, 35 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Speicher et al. (U.S. patent No. 6,638,408) in view of Murakawa, et al. (JP 03118462). Applicant traverses for at least the following reasons.

At the outset, the Office Action fails to establish a *prima facie* case of obviousness required under 35 U.S.C. §103. The Examiner has the obligation to identify the suggestion or motivation to modify or combine any of the cited references to show, teach, or suggest all of the limitations of the recited claims. The teaching or suggestion to combine any of these references must be found in the prior art. MPEP §2142. The Office Action fails to identify any teaching or suggestion in the prior art that the Speicher reference or Murakawa reference should be combined or modified. A bare statement that “it would have been obvious to one of ordinary skill in the art” is insufficient. MPEP §2143.01. Accordingly the first requirement in establishing a *prima facie* case of obviousness has not been met.

Second, the Office Action has not articulated a reasonable expectation of success in combining the Speicher or Murakawa references. *See* MPEP §2143. Without this, the second requirement in establishing a *prima facie* case of obviousness has not been met.

Third, neither the Speicher reference nor the Murakawa reference (to the extent that the English translation describes the invention) disclose “a non-isoelectric separation barrier” as required by the recited claims. By contrast, both these cited references explicitly describe either a isoelectric focusing membrane partitions or molecular-weight partitioning films. Neither

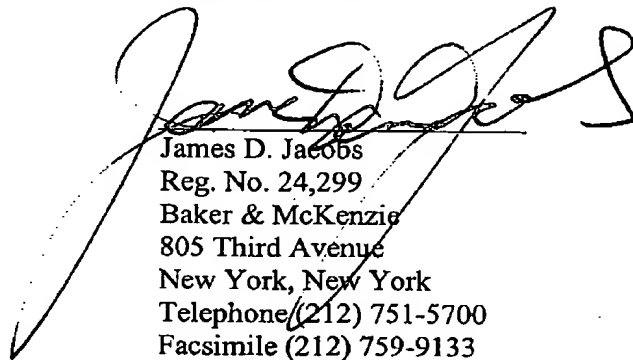
Speicher or Murakawa, either singly or combined, teach, suggest, or disclose the required limitations recited in the present claims. As such, the Office Action also fails to meet this requirement in establishing a *prima facie* case of obviousness. Applicant respectfully requests that rejection of claims 1-11, 14-25, 28-32, 35 and 36 based on obviousness be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance, and favorable action is hereby requested. If a telephone interview would be of assistance in advancing prosecution of the subject application, the Examiner is requested to telephone the undersigned at the number provided below. If the Commissioner determines that additional fees are due, please charge our Deposit Account No. 02-0393, Attorney Docket No. 56104576-82.

Dated: May 12, 2004

Respectfully submitted,



James D. Jacobs
Reg. No. 24,299
Baker & McKenzie
805 Third Avenue
New York, New York
Telephone (212) 751-5700
Facsimile (212) 759-9133